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|   |             |                      |                            |                  |
|---|-------------|----------------------|----------------------------|------------------|
| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
| 10/655,713  | 09/05/2003  | Quoc Le              | BEAS-01454US6              | 8788             |
| 23910 7590 12/18/2006<br>FLIESLER MEYER LLP<br>650 CALIFORNIA STREET<br>14TH FLOOR<br>SAN FRANCISCO, CA 94108 |             |                      | EXAMINER<br>BACKER, FIRMIN |                  |
|   |             |                      | ART UNIT                   | PAPER NUMBER     |
|   |             |                      | 3621                       |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE              |                  |
| 3 MONTHS  |             | 12/18/2006           | PAPER                      |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/655,713

Applicant(s)

LE ET AL.

Examiner

FIRMIN BACKER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-27 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-30 of copending Application No. 10/655,811. Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Narin et al (U.S. PG Pub 2004/0158709).

5. As per claim 1, Narin et al teach a method comprising: maintaining digital records of software licenses for a group, the digital records indicating rights associated with software licenses, the digital records being accessible by a group member using a web application; and accessing, by the group member, the web application to input information concerning an software license that is not stored in the digital records so as to allow an administrator to add the missing software license (*see abstract, fig 11, paragraphs 0140-0154*).

6. As per claim 2-9, Narin et al teach a method wherein the web application provides the information to the administrator, allows the administrator to accept or deny the missing license and wherein accepted licenses are added to digital records, to request additional information from the group member, web application can be used to adjust the rights associated with the software license, to provide license keys for the software, uses role based security, stores configuration information for the computers running the licensed software (*see abstract, fig 11, paragraphs 0140-0154*).

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7. As per claim 1, Narin et al teach a license management system comprising: a memory adapted to store digital records of software licenses for a group, the digital records indicating rights associated with software licenses, and a processor adapted provide a web application to allow a group member to access the digital records, the web application allowing a group member to input information concerning an software license that is not stored in the digital records so as to allow an administrator to add the missing software license (*see abstract, fig 11, paragraphs 0140-0154*).

8. As per claim 11-18, Narin et al teach a method wherein the web application provides the information to the administrator, allows the administrator to accept or deny the missing license and wherein accepted licenses are added to digital records, to request additional information from the group member, web application can be used to adjust the rights associated with the software license, to provide license keys for the software, uses role based security, stores configuration information for the computers running the licensed software (*see abstract, fig 11, paragraphs 0140-0154*).

9. As per claim 19, Narin et al teach a computer readable media comprising software to instruct a computer to do the steps of: maintaining digital records of software licenses for a group, the digital records indicating rights associated with software licenses, the digital records being accessible by a group member using a web application; and in response to accessing, by the group member, the web application to input information concerning an software license that

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is not stored in the digital records, enabling an administrator to add the missing software license (*see abstract, fig 11, paragraphs 0140-0154*).

10. As per claim 20-27, Narin et al teach a method wherein the web application provides the information to the administrator, allows the administrator to accept or deny the missing license and wherein accepted licenses are added to digital records, to request additional information from the group member, web application can be used to adjust the rights associated with the software license, to provide license keys for the software, uses role based security, stores configuration information for the computers running the licensed software (*see abstract, fig 11, paragraphs 0140-0154*).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

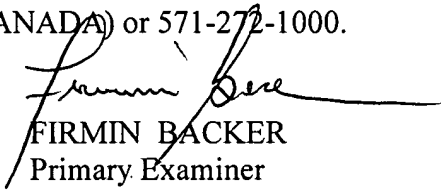
Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMIN BACKER whose telephone number is 571-272-6703.

The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



FIRMIN BACKER  
Primary Examiner  
Art Unit 3621

December 8, 2006